



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,764	06/30/2003	Vassoudevane Lebonheur	884.862US1	5896
21186	7590	07/27/2005		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938				
EXAMINER				
MANDALA, VICTOR A				
ART UNIT		PAPER NUMBER		
2826				

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,764

Applicant(s)

LEBONHEUR ET AL.

Examiner

Victor A. Mandala Jr.

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/11/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/ Restriction

1. The election made on 1/10/05 was made without traverse. The Applicant traversed the election made on 5/11/05. The examiner has considered all of the arguments, but finds them to be non-persuasive. Both elections are made final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 14-17, 20, 21, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,434,017 Iwabuchi.

2. Referring to claim 1, an article comprising: a first die disposed upon a mounting substrate, (Figure 3 #2), wherein the first die, (Figure 3 #1), includes a first die, (Figure 3 #1), active first surface and a first die backside second surface; and a molding compound cap, (Figure 3 #3), abutting the first die, (Figure 3 #1), and including a third surface that originates substantially above the first die, (Figure 3 #1), active first surface and below the first die backside second surface.

3. Referring to claim 2, an article, wherein the third surface that originates substantially above the first die, (Figure 3 #1), active first surface includes: a meniscus, (Figure 3 #3), that originates substantially above the first die, (Figure 3 #1), active first surface; and a substantially planar surface that is selected from parallel planar to the first

Art Unit: 2826

die, (Figure 3 #1), active first surface, and located above the first die active first surface at a height that is a fraction of the die height.

4. Referring to claim 3, an article, wherein the third surface that originates substantially above the first die, (Figure 3 #1), active first surface, includes: a meniscus, (Figure 3 #3), that originates substantially above the first die, (Figure 3 #1), active first surface, and wherein the meniscus, (Figure 3 #3), is selected from a capillary action meniscus and an imposed meniscus.

5. Referring to claim 4, an article, wherein the third surface that originates substantially above the first die, (Figure 3 #1), active first surface includes: a meniscus, (Figure 3 #3), that originates substantially above the first die, (Figure 3 #1), active first surface; and a substantially planar surface that is coplanar to the first die, (Figure 3 #1), active first surface.

6. Referring to claim 14, a computing system comprising: a first die disposed upon a mounting substrate, (Figure 3 #2), wherein the first die, (Figure 3 #1), includes a first die active first surface and a first die, (Figure 3 #1), backside second surface; and a molding compound cap, (Figure 3 #3), abutting the first die and including a third surface that originates substantially above the first die, (Figure 3 #1), active first surface and below the first die, (Figure 3 #1), backside second surface; and dynamic random-access data storage coupled, (Col. 1 and Figure 4), to the first die, (Figure 3 #1).

7. Referring to claim 15, a computing system, wherein the computing system is disposed in one of a computer, a wireless communicator, a hand-held device, an automobile, a locomotive, an aircraft, a watercraft, and a spacecraft, (Col. 1 and Figure 4).

Art Unit: 2826

8. Referring to claim 16, a computing system according to claim 14, wherein the microelectronic die is selected from a data storage device, a digital signal processor, a micro controller, an application specific integrated circuit, and a microprocessor, (Col. 1 and Figure 4).

9. Referring to claim 17, a computing system, wherein the third surface that originates substantially above the first die, (Figure 3 #1), active first surface includes: a meniscus, (Figure 3 #3), that originates substantially above the first die, (Figure 3 #1), active first surface; and a substantially planar surface that is selected from parallel planar to the first die, (Figure 3 #1), active first surface, and located above the first die, (Figure 3 #1), active first surface at a height that is a fraction of the die height.

10. Referring to claim 20, a processing system comprising: a mold chase, (Figure 3 #3); including a profile that is capable of causing molding cap compound to originate on a die, (Figure 3 #1), at a die height that is substantially above the die active surface and below the die backside surface.

11. Referring to claim 21, a processing system, wherein the profile is capable of forming a meniscus, (Figure 3 #3), where the molding cap compound originates, wherein the meniscus is formed as one selected from a capillary action meniscus and an imposed meniscus.

12. Referring to claim 24, a process comprising: forming a molding compound cap over a first die, (Figure 3 #1), that is disposed upon a substrate, wherein the first die includes a first die active first surface and a first die, (Figure 3 #1), backside second surface, and wherein forming the molding compound cap, (Figure 3 #3), includes

Art Unit: 2826

forming a molding compound cap, (Figure 3 #3), third surface that is above the first die active first surface and below the first die, (Figure 3 #1), backside second surface.

13. Referring to claim 25, a process, wherein forming a molding compound cap, (Figure 3 #3), third surface includes forming the meniscus, (Figure 3 #1), selected from a capillary action meniscus and an imposed meniscus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,434,017 Iwabuchi.

14. Referring to claim 28, a process, wherein forming the molding compound cap includes injection molding the molding compound with a particulate.

Initially, and with respect to claim 28, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

As to the grounds of rejection under section 103, see MPEP § 2113

Claim Rejections - 35 USC § 103

Art Unit: 2826

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7-13, 18, 19, 22, 23, 26, 27, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,434,017 Iwabuchi in view of U.S. Patent No.

15. Referring to claim 5, an article, further including a second die disposed upon the mounting substrate, (Iwabuchi Figure 3 #2), wherein the second die, (Naka et al. Figure 18 #1), includes a second die, (Naka et al. Figure 18 #1), active first surface and a second die, (Naka et al. Figure 18 #1), backside second surface, and wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the second die, (See ** below).

** Iwabuchi discloses the claimed invention except for a second or third die, but Naka et al. does. It would have been obvious to one having skill in the art at the time the invention was made to make multiple dies, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. vs. Bomis Co. 193USPQ8

16. Referring to claim 7, an article, further including a second die, (Naka et al. Figure 18 #1), disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the second die, (Naka et al. Figure 18 #1), includes a second die, (Naka et al. Figure 18 #1), active first surface and a second die backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the second die, and wherein the molding

Art Unit: 2826

compound includes a curvilinear profile between the first die, (Iwabuchi Figure 3 #1), and the second die, (Naka et al. Figure 18 #1), (See ** above).

17. Referring to claim 8, an article, further including: a second die, (Naka et al. Figure 18 #1), disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the second die includes a second die, (Naka et al. Figure 18 #1), active first surface and a second die, (Naka et al. Figure 18 #1), backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the second die; and a last die disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the last die, (Naka et al. Figure 18 #1), includes a last die active, (Naka et al. Figure 18 #1), first surface and a last die, (Naka et al. Figure 18 #1), backside second surface, wherein the molding compound, (Naka et al. Figure 18 #4), cap abuts the last die, (See ** above).

18. Referring to claim 9, an article, further including: a second die, (Naka et al. Figure 18 #1), disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the second die, (Naka et al. Figure 18 #1), includes a second die, (Naka et al. Figure 18 #1), active first surface and a second die backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the second die; a last die disposed upon the mounting substrate, (Naka et al. Figure 18 #1), wherein the last die, (Naka et al. Figure 18 #1), includes a last die active first surface and a last die backside second surface, wherein the molding compound, (Naka et al. Figure 18 #2), cap abuts the last die; and wherein the first die, (Iwabuchi Figure 3 #2), the second die, (Naka et al. Figure 18 #1), and the last die, (Naka et al. Figure 18 #1), are arranged in a configuration selected from: the first die, (Iwabuchi Figure 3 #2), the second die, (Naka et al. Figure 18 #2), and the last die, (Naka et al. Figure 18 #1), are disposed in a single molding

Art Unit: 2826

compound cap, (Naka et al. Figure 18 #2), structure; the first die, the second die, (Naka et al. Figure 18 #1), and the last die, (Naka et al. Figure 18 #1), are each disposed in separate molding compound cap structures; the first die and the second die, (Naka et al. Figure 18 #1), are disposed in a single molding compound cap structure, and at least two occurrences of the last die are disposed in a single molding compound, (Naka et al. Figure 18 #2), cap structure; and the first die and the second die, (Naka et al. Figure 18 #1), are each disposed in separate molding compound cap, (Naka et al. Figure 18 #2), structures, and at least two occurrences of the last die are disposed in a single molding compound cap, (Naka et al. Figure 18 #2), structure, (See ** above).

19. Referring to claim 10, a package comprising: a first die, (Iwabuchi Figure 3 #1), disposed upon a mounting substrate, (Iwabuchi Figure 3 #2), wherein the first die, (Iwabuchi Figure 3 #1), includes a first die, (Iwabuchi Figure 3 #1), active first surface and a first die backside second surface; a molding compound cap, (Iwabuchi Figure 3 #3), abutting the first die, (Iwabuchi Figure 3 #1), and including a third surface that originates substantially above the first die, (Iwabuchi Figure 3 #1), active first surface and below the first die, (Iwabuchi Figure 3 #1), backside second surface; and a heat spreader, (Naka et al. Figure 18 #6), bonded to the first die backside second surface, (See *** below).

*** Iwabuchi is silent on having a heat spreader and heat sink added to the chip design, but Naka et al. does teach it. It would have been obvious to one having skill in the art at the time the invention was made to combine the teachings of Naka et al. with the teachings of Iwabuchi because the addition of a heat spreader and sink allows for the chip to operate at cooler temperatures resulting in better performance and reliability.

Art Unit: 2826

20. Referring to claim 11, a package, further including: a heat sink, (Naka et al. Figure 18 #7), in thermal contact with the heat spreader, (Naka et al. Figure 18 #6) and See *** above).
12. Referring to claim 12, a package, wherein the third surface that originates substantially above the first die, (Iwabuchi Figure 3 #1), active first surface, includes: a meniscus, (Iwabuchi Figure 3 #3), that originates substantially above the first die, (Iwabuchi Figure 3 #1), active first surface; and a substantially planar surface that is selected from parallel planar to the first die, (Iwabuchi Figure 3 #1), active first surface, and located above the first die, (Iwabuchi Figure 3 #1), active first surface at a height that is a fraction of the die height.
21. Referring to claim 13, a package, further including: a second die, (Naka et al. Figure 18 #1), disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the second die, (Naka et al. Figure 18 #1), includes a second die active first surface and a second die, (Naka et al. Figure 18 #1), backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the second die, (Naka et al. Figure 18 #1); and a last die, (Naka et al. Figure 18 #1), disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the last die, (Naka et al. Figure 18 #1), includes a last die, (Naka et al. Figure 18 #1), active first surface and a last die, (Naka et al. Figure 18 #1), backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the last die, (See ** above).
22. Referring to claim 18, a computing system, further including a second die disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the second die, (Naka et al. Figure 18 #1), includes a second die, (Naka et al. Figure 18 #1), active first

Art Unit: 2826

surface and a second die, (Naka et al. Figure 18 #1), backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the second die, (Naka et al. Figure 18 #1); and a last die, (Naka et al. Figure 18 #1), disposed upon the mounting substrate, wherein the last die, (Naka et al. Figure 18 #1), includes a last die active first surface and a last die, (Naka et al. Figure 18 #1), backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the last die, (Naka et al. Figure 18 #1) and See ** above).

23. Referring to claim 19, a computing system, further including a second die, (Naka et al. Figure 18 #1), disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the second die, (Naka et al. Figure 18 #1), includes a second die, (Naka et al. Figure 18 #1), active first surface and a second die, (Naka et al. Figure 18 #1), backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the second die, (Naka et al. Figure 18 #1); and a last die disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the last die, (Naka et al. Figure 18 #1), includes a last die, (Naka et al. Figure 18 #1), active first surface and a last die, (Naka et al. Figure 18 #1), backside second surface, wherein the molding compound cap, (Naka et al. Figure 18 #2), abuts the last die, (Naka et al. Figure 18 #1) and See ** above)..

24. Referring to claim 22, a processing system, wherein the profile is capable of imposing an exposed upper surface upon a mounting substrate, (Iwabuchi Figure 3 #2), at a position between a first die, (Iwabuchi Figure 3 #1), cavity in the mold chase and a second die, (Naka et al. Figure 18 #1), cavity in the mold chase, (Naka et al. Figure 18 #2) and See ** above).

Art Unit: 2826

25. Referring to claim 23, a processing system according to claim 20, wherein the profile includes a first die cavity, (Iwabuchi Figure 3 #1), a second die cavity, (Naka et al. Figure 18 #1), contiguous the first die cavity, (Iwabuchi Figure 3 #1), and a last die cavity, (Naka et al. Figure 18 #1), contiguous the first die cavity, wherein the first die cavity, (Iwabuchi Figure 3 #1), the second die cavity, (Naka et al. Figure 18 #1), and the last die cavity, (Naka et al. Figure 18 #1), are arranged in a configuration selected from: the first die cavity, (Iwabuchi Figure 3 #1), the second die cavity, (Naka et al. Figure 18 #1), and the last die cavity, (Naka et al. Figure 18 #1), are disposed in a single molding compound cap cavity, (Naka et al. Figure 18 #2); the first die cavity, (Iwabuchi Figure 3 #1), the second die cavity, (Naka et al. Figure 18 #1), and the last die cavity, (Naka et al. Figure 18 #1), are each disposed in separate molding compound cap cavities, (Naka et al. Figure 18 #2); the first die cavity, (Iwabuchi Figure 3 #1), and the second die cavity, (Naka et al. Figure 18 #1), are disposed in a single molding compound cap cavity, and at least two occurrences of the last die cavity, (Naka et al. Figure 18 #1), are disposed in a single molding compound cap cavity, (Naka et al. Figure 18 #2); and the first die cavity, (Iwabuchi Figure 3 #1), and the second die cavity, (Naka et al. Figure 18 #1), are each disposed in separate molding compound cap, (Naka et al. Figure 18 #2), cavities, and at least two occurrences of the last die, (Naka et al. Figure 18 #1), are disposed in a single molding compound cap cavity, (Naka et al. Figure 18 #2) and See ** above)..

26. Referring to claim 26, a process, further including: forming the molding compound cap, (Naka et al. Figure 18 #2), over a second die, (Naka et al. Figure 18 #1), that is disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the second die, (Naka et al. Figure 18 #1), includes a second die, (Naka et al. Figure 18 #1),

Art Unit: 2826

active first surface and a second die, (Naka et al. Figure 18 #1), backside second surface, and wherein forming the molding compound cap, (Naka et al. Figure 18 #2), includes forming the molding compound cap, (Naka et al. Figure 18 #2), third surface above the second die, (Naka et al. Figure 18 #1), active first surface and below the second die backside, (Naka et al. Figure 18 #1), second surface, (See ** above).

27. Referring to claim 27, a process, further including: forming the molding compound cap over a last die, (Naka et al. Figure 18 #1), that is disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the last die, (Naka et al. Figure 18 #1), includes a last die, (Naka et al. Figure 18 #1), active first surface and a last die, (Naka et al. Figure 18 #1), backside second surface, and wherein forming the molding compound cap, (Naka et al. Figure 18 #2), includes forming the molding compound cap, (Naka et al. Figure 18 #2), third surface above the last die active, (Naka et al. Figure 18 #1), first surface and below the last die, (Naka et al. Figure 18 #1), backside second surface, (See ** above).

28. Referring to claim 29, a process, further including: forming the molding compound cap, (Naka et al. Figure 18 #2), over a second die, (Naka et al. Figure 18 #1), that is disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the second die, (Naka et al. Figure 18 #1), includes a second die active, (Naka et al. Figure 18 #1), first surface and a second die, (Naka et al. Figure 18 #1), backside second surface, and wherein forming the molding compound cap, (Naka et al. Figure 18 #2), includes forming the molding compound cap, (Naka et al. Figure 18 #2), third surface above the second die, (Naka et al. Figure 18 #1), active first surface and below the second die, (Naka et al. Figure 18 #1), backside second surface; and forming the molding compound

Art Unit: 2826

cap, (Naka et al. Figure 18 #2), over a last die that is disposed upon the mounting substrate, (Naka et al. Figure 18 #4), wherein the last die includes a last die, (Naka et al. Figure 18 #1), active first surface and a last die, (Naka et al. Figure 18 #1), backside second surface, and wherein forming the molding compound cap, (Naka et al. Figure 18 #2), includes forming the molding compound cap, (Naka et al. Figure 18 #2), third surface above the last die, (Naka et al. Figure 18 #1), active first surface and below the last die backside second surface, (See ** above).

29. Referring to claim 30, a process, wherein forming the molding compound cap is selected from injection molding, in situ thermal curing, pick-and-place coupling the molding compound cap with the first die, and combinations thereof.

Initially, and with respect to claim 28, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

As to the grounds of rejection under section 103, see MPEP § 2113

Art Unit: 2826

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor A. Mandala Jr. whose telephone number is (571) 272-1918. The examiner can normally be reached on Monday through Thursday from 8am till 6pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAMJ
7/25/05

